

## ATTACHMENT B

### REMARKS

By this amendment, Applicants make a minor amendment to claim 21 in order to delete the word "either" which was intended to be deleted by the preliminary amendment. In addition, Claim 18 has been canceled without prejudice as discussed below. Claims 1-17 and 19-25 are thus now presently under examination in the present application. Applicants further respectfully submit that all pending claims are in condition for allowance for reasons as set forth below.

#### 35 U.S.C. §102 Rejections

In the Official Action of October 11, 2007, the Examiner rejected Claims 1-6 and 24 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,417,961 to Nearn et al. ("Nearn"). Nearn is directed to a sunscreen composition having an aqueous phase and an oil phase which contains suspended zinc oxide particles with a particle size range in the nanometric range of about 10 to 250 nanometers.

The invention as presently claimed is directed to a make-up composition comprising cosmetically acceptable fluorescent semiconductor nanoparticles in cosmetic vehicle as the pigment. In sharp contrast to the present claims, Nearn does not disclose or suggest fluorescent zinc oxide nanoparticles. Furthermore, the fluorescent nanoparticles of the present invention have a size which is generally much smaller than the particles suggested by Nearn. For example, the mean particle size of Applicants' fluorescent nanoparticles generally ranges between 1.5 and 15 nanometers (see Applicants' specification, page 5, line 12). Outside of this range, even small semi-

conductor particles are not fluorescent and thus would not fall within the scope of the presently claimed subject matter.

Fluorescent nanoparticles are thus not taught or suggested by Nearn because the cosmetic composition of Nearn is a sunscreen composition and **not** a make-up composition such as in the present application. Moreover, the sunscreen composition found in Nearn does **not** use zinc oxide particles as a pigment. Instead the particles are used merely to block the passage of erythemalogenic radiation and prevent its penetration into the skin.

Accordingly, Claims 1-6 and 24 are not anticipated by the Nearn reference, and the Examiner's rejection of Claims 1-6 and 24 under 35 U.S.C. 102(b) on the basis of this reference is respectfully traversed and should be withdrawn.

#### 35 U.S.C. §103 Rejections

In the Official Action, the Examiner also rejected Claims 1-25 under 35 U.S.C. 103(a) as being obvious over the above Nearn patent in view of U.S. Patent No. 6,319,426 to Bawendi et al. ("Bawendi"). However, the Examiner's rejection was based on an initial assumption that Nearn taught the use of fluorescent particles in a cosmetic which is not correct for reasons as stated above. Instead, Nearn is directed to a **sunscreen** composition, having an oil phase which contains suspended **non-fluorescent** zinc oxide particles which are **not** used as a pigment, in sharp contrast to the present invention relating to a make-up composition having as the pigment cosmetically acceptable fluorescent semiconductor nanoparticles in a cosmetic vehicle. Clearly Nearn **teaches away** from the present invention because it would direct the

skilled practitioner to **non**-fluorescent particles, and moreover does not use its zinc oxide particles as a pigment in a make-up composition.

Moreover, as acknowledged by the Examiner in that there was no assertion that Bawendi contained the same elements the Examiner asserted were found in Nearn, there is no teaching or suggestion in the Bawendi reference which would make up for the elements missing in the Nearn reference. For example, Bawendi merely discloses water soluble semiconductor nano-particles capable of fluorescence, and is totally unrelated to the use of fluorescent semiconductor particles used as a pigment in a make-up composition. The Examiner's rejection was based on the assertion that it would have been obvious to substitute the fluorescent nano-particles of Bawendi into the fluorescent nano-particles in a cosmetic that were alleged to be disclosed in the Nearn patent (see, e.g., Official Action at pages 7-8), but this cannot be the case because Nearn does **not** disclose fluorescent nanoparticles used as a pigment in a make-up composition for reasons as outlined above.

In short, neither of the references cited by the Examiner contain any teaching or motivation whatsoever which would allow the skilled person in this art to have incorporated fluorescent nanoparticles as pigments into the make-up compositions as presently claimed, and thus the Examiner's rejections on the basis of the combination of the cited Nearn and Bawendi references is respectfully traversed and should be withdrawn.

### Obviousness Double Patenting Rejection

Finally, the Examiner rejected Claim 18 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent Application No. 10/219,440. Without addressing the merits of this rejection, Applicants have cancelled Claim 18 without prejudice. Accordingly, the rejection of Claim 18 as being unpatentable on the ground of obviousness-type double patenting is now moot and should be withdrawn.

In light of the arguments as set forth above, Applicants submit that all of the outstanding rejections have been overcome, and that the present application and its pending claims are in condition for immediate allowance. Applicants thus respectfully request the allowance of all of the claims of the pending application.

**END OF REMARKS**